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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,548	02/19/2004	Lee Mizzen	12071-011004	3267
26161	7590	03/14/2006	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			ZEMAN, MARY K	
			ART UNIT	PAPER NUMBER
			1631	
DATE MAILED: 03/14/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/782,548	Applicant(s) MIZZEN ET AL.	
	Examiner Mary K. Zeman	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-12, 42 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 6-12, 42, 49-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 6-9, 10-12, 42 drawn to a DNA vaccine comprising a polynucleotide encoding a fusion of an antigen and a stress protein, classified in class 514, subclass 44. FURTHER RESTRICTION REQUIRED BELOW.
- II. Claims 49-52, drawn to compositions comprising an antigen and a stress protein for an intended use of allergenic suppression, classified in class 424, subclass 184.1. FURTHER RESTRICTION REQUIRED BELOW.

Sequence Election Requirement Applicable to All Groups

In addition, each Group detailed above reads on patentably distinct sequences. Each polynucleotide comprising an antigen and a stress protein is a differing polynucleotide having a differing structure, and differing biological activity and reactivity. Each antigen or composition comprising an antigen and a stress protein in fusion is a distinct sequence having differing chemical and biochemical structure, function, and reactivity. Each sequence is patentably distinct, and a further restriction is applied to each Group. Applicant must further elect a single SEQ ID NO. (See MPEP 803.04). If SEQ ID NO: are not available, a specific election of a single antigen sequence and a single stress protein sequence (to be searched in fusion or together) would meet this requirement. Applicant must specifically identify each of the corresponding claims for the sequence elected.

Applicant is advised that examination will be restricted to only the elected SEQ ID NO. and should not to be construed as a species election.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are independent and distinct as they are drawn to differing compositions of matter having vastly differing structures. Invention I is drawn to polynucleotides, whereas Invention II is drawn to polypeptides. Polypeptides and polynucleotides are differing products having differing structures, functions and activities. Polypeptides, which are composed of amino acids, and polynucleotides which are composed of purine and pyrimidine units are structurally distinct molecules: any relationship between a polynucleotide and a polypeptide is dependent upon the information provided by the nucleic acid sequence open reading frame as it corresponds to the primary amino acid sequence of the encoded polypeptide. In the present claims, a polynucleotide of Group I does not necessarily

Art Unit: 1631

encode a polypeptide of Group II. Furthermore, the information provided by the polynucleotide of Group I can be used to make a materially different polypeptide than that of Group II. For example, a nucleic acid which hybridizes to a polynucleotide encoding a fusion of influenza NP and HSP65, even under stringent conditions, encompasses molecules which contain point mutations, splice sites, frameshift mutations or stop codons which would result in use of a different open reading frame, and thus encode a protein that lacks any significant structure in common. In addition, while a polypeptide of Group II can be made by methods using some of the polynucleotides that fall within the scope of polynucleotide group I, it can also be recovered from a natural source by using biochemical means. For instance the polypeptide can be isolated using affinity chromatography. Furthermore, the search of both inventions together would impose a serious search burden upon the examiner. The search of the polypeptides would not be coextensive with the polynucleotides. The inventions of Groups I and II have a separate status in the art as shown by their differing classifications. Each sequence is searched in appropriate databases. It would not be appropriate to search a nucleotide sequence in an amino acid or protein database. There is an additional search burden in the non-patent literature. Prior to the concomitant isolation and expression of the sequence of interest there may be journal articles that discuss the polypeptide and not the polynucleotide, and "classical genetics" papers which discuss only the gene and not the polypeptide may also be indexed. Therefore the search is not coextensive.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

IF the examiner has required restriction between product and process claims: Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product will be entered** as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. **Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined.** See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised

Art Unit: 1631

that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP 804.01.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (571) 272 0723

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, PhD can be reached on (571) 272 0718. The fax phone number for the organization where this application or proceeding is assigned is 571 273 8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


MARY K. ZEMAN
PRIMARY EXAMINER
1631
3/6/02